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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,055	06/21/2001	Kazunori Masaki	35.C15476	4347
5514	7590	10/19/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			MILIA, MARK R	
			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/885,055

Applicant(s)

MASAKI, KAZUNORI

Examiner

Mark R. Milia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment was received on 7/12/05 and has been entered and made of record. Currently, claims 1-26 are pending.

### ***Drawings***

2. Applicant's amendment to Fig. 1 to remove reference numerals "1000" and "2000" have overcome the objection to the Drawings as cited in the previous Office Action. Therefore the objection has been withdrawn.

### ***Specification***

3. Applicant's amendment to the specification to correct minor informalities has overcome the objection to the specification as cited in the previous Office Action. Therefore the objection has been withdrawn.

***Claim Rejections - 35 USC § 101***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Applicant's amendment to claims 15-21 to make the claims statutory has overcome the rejection to claims 15-22 as being directed to non-statutory subject matter as cited in the previous Office Action. Therefore the rejection has been withdrawn.

6. Applicant's amendment to claim 22 does not overcome the rejection as cited in the previous Office Action. Claim 22 is drawn to a computer program product. Such a claim is non-statutory because the terminology "computer program" alone has no set definition. A statutory product with descriptive material must include a positive recitation of the computer readable medium, see MPEP 2106. Examiner suggests amending the claims to read "A computer program embodied in a computer readable medium for performing the steps of..." or "A computer readable medium storing a program for performing the steps of..." or any other similar wording which best clarifies the claim and includes a positive recitation of the computer readable medium.

***Response to Arguments***

7. Applicant's arguments filed 7/12/05 have been fully considered but they are not persuasive.

8. Upon review of the references of Kurogane and Wakamatsu, which were cited in the Office Action dated 4/6/05, under 35 U.S.C. 103, as disclosing claims 1, 8, and 15, the examiner notes that the references can still be interpreted as disclosing the claims, as currently amended. Particularly, as amended, claims 1, 8, and 15 now require "wherein the printing device outputs a mixture of a first print paper that is not to be folded and a second print paper that is to be folded into a predetermined form, and wherein the first print paper and the second print paper are different in size from each other". Wakamatsu shows the above limitation in Fig. 15B. The claims, as amended, also require "wherein said control means controls the print position to be different for the first print paper in comparison with the second print paper". Kurogane discloses the ability to place additional information, such as page numbers of header information, at various positions on each paper that is to be printed (see Fig. 6 and column 6 line 55-column 7 line 5). The combination of Kurogane and Wakamatsu would yield a system in which the ability to designate the presence/absence of a fold command and the ability to place additional information, such as page numbers, in various position on the page depending on whether the fold operation has been chosen or not. The above combination yields a system with the ability to function in the same manner as that claimed in claims 1, 8, and 15 and therefore discloses all the limitations set forth in these claims. Support for this combination can be found in the references Iwasaki (U.S. Patent Application Publication No. 2001/0039554) and Eisenberg et al. (U.S. Patent No. 6452694). Iwasaki discloses a system in which a plurality of print data is printed on a single sheet of paper, the sheet being folded a plurality of times and correctly paginated

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to accurately number each page to properly yield a book after being folded. Eisenberg discloses a system in which foldable tabs that are to be printed upon place print data so as to be viewed correctly after printing. Both references show that it is known in the art to place information in various positions depending on the presence/absence of folding.

9. In response to applicant's arguments regarding the rejection of claims 1, 8, and 15, wherein on pages 15-17, the applicant explains how the current invention differs from the teachings of Kurogane and Wakamatsu and asserts that the references fail to disclose "control means for controlling a print position of the additional information on a print image corresponding to the print data produced by said producing means, based on of the presence/absence of the fold designation inputted by said input means, wherein said control means controls the print position to be different for the first print paper in comparison with the second print paper". The examiner respectfully disagrees as the combination of Kurogane and Wakamatsu do disclose such a feature as discussed in the arguments above.

10. Therefore, the rejection of claims 1-22, as cited in the previous Office Action, is maintained and repeated in this Office Action. Claims 23-26 will also be addressed in the following rejection.

***Claim Rejections - 35 USC § 103***

11. Claims 1-4, 7-11, 14-18, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5126858 to Kurogane et al. in view of U.S. Patent No. 5905935 to Wakamatsu et al.

Regarding claims 1, 8, 15, and 23, Kurogane discloses a print controlling apparatus, method, and computer readable storage medium storing a program capable of outputting a print paper comprising producing means for producing print data by adding additional information to information to be printed (see Figs. 6 and 7, column 3 line 66-column 4 line 17, column 5 lines 20-64, and column 6 line 55-column 7 line 40) and control means for controlling a print position of the additional information on a print image corresponding to the print data produced by said producing means (see column 6 line 55-column 7 line 40), wherein said control means controls the print position to be different for the first print paper in comparison with the second print paper (see Fig. 6 and column 6 line 55-column 7 line 5).

Kurogane does not disclose expressly input means for inputting information representing presence/absence of the fold designation by an operator.

Wakamatsu discloses wherein the printing device outputs a mixture of a first print paper that is not to be folded and a second print paper that is to be folded into a predetermined form, and wherein the first print paper and the second print paper are different in size from each other (see Fig. 15B) and an input means for inputting

information representing presence/absence of the fold designation by an operator (see Fig. 4 and column 6 lines 1-13).

Kurogane & Wakamatsu are combinable because they are from the same field of endeavor, printing image documents consistent with printing properties specified by a user.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the folding device as part of a finishing routine of Wakamatsu with the system of placing additional information, in the form of page numbers and header information, in locations specified by a user of Kurogane.

The suggestion/motivation for doing so would have been to provide multiple finishing options and destinations for image documents even when enlargement/reduction options have been chosen by a user and increase the amount of information that can be provided on a single sheet of paper, even over-sized paper, and output the image documents without a disruption in print properties.

Therefore, it would have been obvious to combine Wakamatsu with Kurogane to obtain the invention as specified in claims 1, 8, 15, and 23.

Regarding claims 2, 9, 16, and 24, Kurogane and Wakamatsu disclose the system discussed in claim 1, 8, 15, and 23, and Wakamatsu further discloses wherein the predetermined form is Z-fold (see Figs. 15B and 16, column 6 lines 23-27, and column 7 line 65-column 8 line 25).



Regarding claims 3, 10, and 17, Kurogane and Wakamatsu disclose the system discussed in claim 1, 8, and 15, and Kurogane further discloses wherein the additional information is either header information or footer information (see Figs. 6 and 8 and column 7 lines 25-40).

Regarding claims 4, 11, and 18, Kurogane and Wakamatsu disclose the system discussed in claim 1, 8, and 15, and Kurogane further discloses wherein the additional information is either date information or page information (see Figs. 6 and 7 and column 6 line 55-column 7 line 24).

Regarding claims 7, 14, and 21, Kurogane and Wakamatsu disclose the system discussed in claim 1, 8, and 15, and Kurogane further discloses position selecting means for selecting a position for the additional information on the print image from among a plurality of predetermined positions by the operator, and wherein said control means controls the print position of the additional information on the print image, based on the position selected by said position selecting means (see Figs. 6-8 and column 6 line 55-column 7 line 40).

12. Claims 5, 12, 19, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurogane and Wakamatsu as applied to claims 2, 9, 16, and 23 above, and further in view of U.S. Patent No. 6045158 to Bergstresser.

Kurogane and Wakamatsu do not disclose expressly wherein said control means controls the print position of the additional information on the print image ***in such a manner that the additional information can be visually recognized in a condition***

***that a sheet of paper is folded, when the fold designation is present indicating that paper is to be folded.***

Bergstresser discloses wherein said control means controls the print position of the additional information on the print image ***in such a manner that the additional information can be visually recognized in a condition that a sheet of paper is folded, when the fold designation is present indicating that paper is to be folded*** (see Figs. 3a-c, column 4 lines 20-23 and 36-41, and column 5 lines 21-28).

Kurogane, Wakamatsu, & Bergstresser are combinable because they are from the same field of endeavor, printing documents consistent with printing and finishing properties specified by a user.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the printing of indexing and other information on the margin areas of paper as to be viewable when the paper is folded and unfolded.

The suggestion/motivation for doing so would have been to allow the user to easily view index information to open directly to a specific page to obtain the desired information (see column 5 lines 23-28 of Bergstresser).

Therefore, it would have been obvious to combine Bergstresser with Kurogane and Wakamatsu to obtain the invention as specified in claims 5, 12, 19, and 25.

13. Claims 6, 13, 20, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurogane and Wakamatsu as applied to claims 5, 12, 19, and 23 above, and further in view of U.S. Patent No. 6045158 to Bergstresser.

Kurogane and Wakamatsu do not disclose expressly wherein control means controls the print position of the additional information on the print image ***in such a manner that the additional information can be visually recognized also in a condition that a sheet of paper is not folded, when the fold designation is present indicating that paper is to be folded.***

Bergstresser discloses wherein control means controls the print position of the additional information on the print image ***in such a manner that the additional information can be visually recognized also in a condition that a sheet of paper is not folded, when the fold designation is present indicating that paper is to be folded*** (see Fig. 2, figure shows that the additional information, which is located in regions 3a-d, is visible even when the paper is not folded).

Kurogane, Wakamatsu, & Bergstresser are combinable because they are from the same field of endeavor, printing documents consistent with printing and finishing properties specified by a user.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the printing of indexing and other information on the margin areas of paper as to be viewable when the paper is folded and unfolded.

The suggestion/motivation for doing so would have been to allow the user to easily view index information to open directly to a specific page to obtain the desired information (see column 5 lines 23-28 of Bergstresser).

Therefore, it would have been obvious to combine Bergstresser with Kurogane and Wakamatsu to obtain the invention as specified in claims 6, 13, 20, and 26.

***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. To further show the state of the art refer to U.S. Patent No. 6452694 (Eisenberg et al.).

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

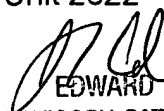
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached at (571) 272-7402. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MRM

Mark R. Milia  
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